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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/726,013

12/03/2003

Koji Utsugi

03043-1

2616

21254

7590

11/27/2007

MCGINN INTELLECTUAL PROPERTY LAW GROUP, PLLC

8321 OLD COURTHOUSE ROAD

SUITE 200

VIENNA, VA 22182-3817

EXAMINER

WEINER, LAURA S

ART UNIT

PAPER NUMBER

1795

MAIL DATE

DELIVERY MODE

11/27/2007

PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

## Office Action Summary

**Application No.**

10/726,013

**Applicant(s)**

UTSUGI ET AL.

**Examiner**

Laura S. Weiner

**Art Unit**

1795

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 15 October 2007 and 13 November 2007.
- 2a) ☒ This action is **FINAL**.                      2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-23 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-23 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: \_\_\_\_\_

## **DETAILED ACTION**

### ***Response to Arguments***

1. Applicant's arguments filed 10-15-07 have been fully considered but they are not persuasive. The rejection of claims 1-23 on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1-28 of U.S. Patent No. 7,163,768 still remains. No terminal disclaimer has been filed. It is unclear why a certified translation of JP 2002-170228 has been filed because in the Oaths filed 12-3-03 and 6-28-04 both state that foreign priority is not claimed. There is no foreign priority claimed in this application.
2. The rejection of claims 1-23 under 35 U.S.C. 102(e) as being anticipated by Utsugi et al. (7,163,768) has been withdrawn because a Declaration under 35 USC 1.131 was filed reducing to practice before August 26, 2003.

### ***Double Patenting***

3. Claims 1-23 are rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1-28 of U.S. Patent No. 7,163,768. Although the conflicting claims are not identical, they are not patentably distinct from each other because US Patent 7,163,768 claims in claim 1 an electrolyte solution for a battery comprising a non-proton solvent and a cyclic sulfonic ester including at least 2 sulfonyl groups. US Patent 7,163,768 claims in claim 2 that the cyclic sulfonic ester is a compound represented by formula (1). US Patent 7,163,768 claims in claim 12 that the

Art Unit: 1795

compound having at least one sulfonyl group is a sultone compound of formula (9). US Patent 7,163,768 claims in claims 13-16 that the electrolyte solution further comprises an imide anion and a transition metal ion such as a lanthanoid transition metal ion. US Patent 7,163,768 claims in claim 11 that the electrolyte further comprises a lithium salt such as LiPF<sub>6</sub>, LiBF<sub>4</sub>, etc. and claims in claim 20 that the electrolyte comprises a vinylene carbonate. US Patent 7,163,768 claims in claims 17 and 19 that 0.005% wt - 10% wt of the imide anion and the cyclic sulfonic ester is present in the electrolyte. US Patent 7,163,768 claims in claim 21 that the solvents can be cyclic carbonates, linear carbonates, etc. US Patent 7,163,768 teaches in claims 23-28 that a battery comprises a cathode, an anode and the electrolyte where the cathode is a lithium-containing combined oxide and the anode comprises an amorphous graphite carbon material.

### ***Conclusion***

4. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of

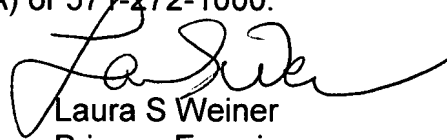
Art Unit: 1795

the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Laura S. Weiner whose telephone number is 571-272-1294. The examiner can normally be reached on M-F (6:30-4:00).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Patrick Ryan can be reached on 571-272-1292. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

  
Laura S Weiner  
Primary Examiner  
Art Unit 1795

November 26, 2007